

## REMARKS

Reconsideration of the above-identified application is respectfully requested. Upon entry of this Amendment, claims 26-40 are pending. Claims 26-40 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,592,375 to *Salmon et al.* No new matter is submitted.

### Rejections Under 35 U.S.C §103

#### **Independent claim 26**

Independent claim 26 requires, *inter alia*, that the "...aggregated first data describing the plurality of suppliers comprises...quantitative indicators of supplier qualities including at least one of quantity of patents held, magnitude or quantity of grants received, and magnitude or quantity of contracts awarded..."

Independent claim 26 also requires, *inter alia*, that the "aggregated second data describing the project comprises...quantitative indicators of particular supplier qualities including at least one of desired minimum quantity of patents held, particular minimum magnitude or quantity of grants received, and particular minimum magnitude or quantity of contracts awarded..."

The Office action states (at page 6) that the "differences" are "only found in nonfunctional descriptive material and are not functionally involved in the steps recited." Applicants respectfully submit that the Office action does not offer support for this allegation that the claim language is nonfunctional. The Office action's allegation that claim 26 is obvious appears to rest on dismissing claim language as "nonfunctional descriptive material."

The Office action cites case law, specifically *In re Gulack* 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Lowry* 32 F3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Both of these cases actually involved Federal Circuit reversals of claim rejections. *In re Gulack* (at pp. 403-404) makes clear that

Differences between an invention and the prior art cited against it cannot be ignored merely because those difference reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the board meant to disregard that basic principle of claim interpretation, we must reverse the rejection as a matter of law."

The result of the case was that the board's affirmation of a claim rejection was reversed by the Federal Circuit. Reversing the board's affirmation of the claim rejection, the Federal Circuit found

that a function relationship does exist between the printed matter and the substrate. A functional relationship of the precise type found by the CCPA in *Miller* – to size or to type of substrate, or conveying information about substrate – is not required. What is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

*In re Lowry* also reversed a rejection of appealed claims. The Federal Circuit pointed out (at page 1034-35) that

...if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed.

The Federal Circuit also pointed out at page 1035 that

As part of its burden to establish a prima facie case of obviousness,...the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. "If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent."

quoting *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In its conclusion, the Federal Circuit reiterated that "The Board erred by denying patentable weight to Lowry's data structure limitations."

Applicant respectfully submits that the Office action has not met "the burden of establishing the absence of a novel, nonobvious functional relationship." The Office action recognizes (at page 6) that *Salmon et al.* does not expressly show a quantity of patents held and a quantity of grants received. Applicants submit that *Salmon et al.* also does not expressly show a quantity of contracts awarded, as recited in the claims. The Office action recognizes that there are differences between the language of the claim and the cited reference, and the Office action has not shown why these differences can be dismissed as "nonfunctional descriptive material."

Despite recognizing that that *Salmon et al.* does not expressly show a quantity of patents held and a quantity of grants received at page 6, the Office action at page 5 appears to indicate that *Salmon et al.* does suggest “quantitative indicators of supplier qualities including at least one of quantity of patents held, magnitude or quantity of grants received, and magnitude or quantity of contracts awarded...” and cites *Salmon et al.* generally at figures 3b, 4a-4q, 5, 6a-6e, 7a-7n along with column 1, lines 18-68, column 2, lines 1-55, column 3, lines 14-48, column 4, lines 36-64, column 5, lines 5-24, column 7, lines 40-58, column 8, lines 4-61, column 10, lines 10-56, column 14, lines 35-68, and column 15, lines 1-21.

However, none of the cited excerpts teach, disclose or suggest “...quantitative indicators of particular supplier qualities including at least one of desired minimum quantity of patents held, particular minimum magnitude or quantity of grants received, and particular minimum magnitude or quantity of contracts awarded...” For example, FIG. 3b of *Salmon et al.* shows “the process that the Seller’s Interface uses to obtain a Product Profile.” (col. 6, lines 25-26). “In step 370, the Seller’s Interface presents a series of questions such as ‘What was your most significant accomplishment in your most recent job?’” *Salmon et al.* teaches that the candidate’s response to each question is captured as audio and/or video information in step 372 (column 6, lines 52-55) and that documents may be “scanned-in” (line 62). A “character recognizer” is used (column 6, line 64) and “resulting text” is presented “to the seller for review and correction” (column 7, line 1). The buyer then enters “unstructured word associations” (among criteria; *See* column 7, line 54) and the database server retrieves database rows (column 7, line 67). With both seller and buyer information, *Salmon et al.* teaches “queries” that “attempt to match an entire row, for example...or may match only a partial row...” (column 5, lines 6-8).

Applicants respectfully submit that audio and/or video information and “resulting text” does not teach or suggest a quantity or a magnitude as recited in the claim 26. In fact, that there is no teaching or suggestion in *Salmon et al.* to provide “...quantitative indicators...” as recited in claim 26.

Even if patents, grants, and contracts were “scanned-in” (and there is no teaching or suggestion in *Salmon et al.* of scanning anything specific other than “work samples or a resume” at column 6, lines 62-63), there is no teaching or suggestion to provide a “quantity” of patents held, particular minimum “magnitude” or “quantity” of grants received, and particular minimum “magnitude” or “quantity” of contracts awarded.

### **Independent claim 32**

Independent claim 32 requires, *inter alia*, that the ""the aggregated first data describing the plurality of suppliers comprises for each supplier...quantitative indicators of supplier qualities including at least one of quantity of patents held, magnitude or quantity of grants received, and magnitude or quantity of contracts awarded" and that the "aggregated second data describing the project comprises...quantitative indicators of particular supplier qualities including at least one of desire minimum quantity of patents held, particular minimum magnitude or quantity of grants received, and particular minimum magnitude or quantity of contracts awarded."

In section 7 of the Office action, the Examiner has grouped claim 26 and claim 33 ("Claims 26-37 are rejected..."). Therefore, the arguments presented above with respect to claim 26 are also applicable to claim 33.

Claim 26 and claim 32 are therefore in condition for allowance, and applicants respectfully request that the rejection of these claims be withdrawn. Claims 27-31 and claims 33-40 are dependent and therefore require at least what is recited in the claims from which they depend. Accordingly, applicants respectfully request that the rejection of these claims be withdrawn as well.

### CONCLUSION

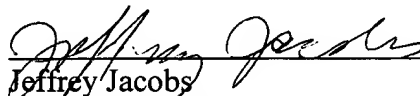
Reconsideration is respectfully requested. Applicants believe the case is in condition for allowance and respectfully request withdrawal of the rejections and allowance of the pending claims.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**.

The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

Date: 3/24/05

  
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